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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,867	09/30/2005	Hideyuki Suzuki	09857-0203438-US0	2011

7278 7590 02/13/2007

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EXAMINER	
LAM, ANN Y	
ART UNIT	**PAPER NUMBER**
1641	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	02/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No.	Applicant(s)	
	10/551,867	SUZUKI ET AL.	
	Examiner	Art Unit	
	Ann Y. Lam	1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 November 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) *1-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restriction

This application contains the following inventions or groups of inventions which are not linked as to form a single inventive concept under PCT Rule 13.1.

Group I, claims 1-11 and 17, drawn to a method of detecting a fluorescent molecule, and/or substance and/or judging the types of substances to be measured, classified in class 435, subclass 4.

Group II, claims 12-16, drawn to a method of analyzing a fluorescent molecule in a test sample, classified in class 356, subclass 346

Group III, claims 18-20, drawn to a kit or apparatus for detecting a fluorescent molecule or determining a substance, classified in class 436, subclass 172.

The inventions listed as Groups I-III do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack a common special technical feature over the prior art for the following reasons:

The inventions are linked together by a device that is capable of measuring in a time-dependent manner individual fluorescence intensities of a plurality of species of fluorescent molecules each having an inherent fluorescence lifetime, and/or comparing the measured fluorescence intensities (because the method claims of Groups I and II

require this measuring and comparing step and the device claims of Group III require elements that are capable of performing these steps.)

However, Alfano et al., 5,635,402, disclose a device for measuring the intensity of fluorescence at a wavelength indicative of fluorescence of a dye and a computer that processes the signals and calculates a ratio or difference for each set of intensity readings at wavelengths λ_D (wavelength that is characteristic of fluorescence for the type of dye used to stain tile cells in a sample) and λ_N (wavelengths that is characteristic of native fluorescence for the cells in the sample), and compares the results to standards (col. 4, lines 38-44, and col. 5, lines 24-30, and col. 5, line 64 – col. 6 line 6).

Thus, Alfano et al. disclose a device that is capable of measuring individual fluorescence intensities of a plurality of species of fluorescent molecules each having an inherent fluorescence lifetime, (and the measuring is inherently in a time-dependent manner), and/or comparing the measured fluorescence intensities.

Therefore the inventions I-III do not form a general inventive concept as they do not share a common special technical feature over the prior art.

Therefore, the technical feature linking the inventions of groups I-III does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

The special technical feature of Group I is considered to be a *method* of detecting a fluorescent molecule in a test sample, comprising the step of measuring individual fluorescence intensities of a plurality of species of fluorescent molecules, *and comparing* the measured fluorescence intensities.

The special technical feature of Group II is considered to be measuring fluorescence intensities of a plurality of species of fluorescent molecules and preparing a fluorescence lifetime function represented by *formula I* (see claim 12 for formula I.)

The special technical feature of Group III is considered to be an *apparatus* for detecting a fluorescent molecule in a test sample comprising means for measuring individual intensities of a plurality of species of fluorescent molecules each having an inherent fluorescence lifetime; and means for comparing the measured fluorescence intensities.

Accordingly, Groups I-III are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

Moreover, the search for all the groups would be a serious burden on examiner because the inventions have acquired a separate status in the art in view of their different classification, and the search for all the elements of one group is not required for a search for all the other elements of the other groups, thus restriction for examination purposes as indicated is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is 571-272-0822. The examiner can normally be reached on Mon.-Fri. 10-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

2/8/07

ANN YEN LAM
PATENT EXAMINER